UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/566,871	02/02/2006	Hiroshi Mukaihara	45010005211	2222

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EXAMINER
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ART UNIT	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

	Application No.	Applicant(s)
Office Action Summary	10/566,871	MUKAIHARA ET AL.
	Examiner	**Art Unit**	
	Mark A. Giardino	2100	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>02 February 2006</u>.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>9-15</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>9-15</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on <u>02 February 2006</u> is/are: a)☒ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☒ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>2/2/06</u>.

4)☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ .

5)☐ Notice of Informal Patent Application

6)☐ Other: _____ .

The information disclosure statement filed February 2, 2006 fails to comply with

37 CFR 1.98(a)(3) because it does not include a concise explanation of the relevance,

as it is presently understood by the individual designated in 37 CFR 1.56(c) most

knowledgeable about the content of the information, of each patent listed that is not in

the English language. It has been placed in the application file, but the information

referred to therein has not been considered.

The disclosure is objected to because of the following informalities: various

grammatical and spelling errors on pages 1-14.

Appropriate correction is required.

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 12 rejected under 35 U.S.C. 101 because the disclosed invention is inoperative

and therefore lacks utility. The host machine is made to execute step (c) "of outputting

at least one of said image data and audio data to said memory device" before step (a)

of "detecting a detection signal indicating that a terminal of a portable memory device is

connected to said interface." One skilled in the art would believe that before any data

transfer could occur, the host machine must be aware of the device's presence. The

specification does not clarify this matter.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly
claiming the subject matter which the applicant regards as his invention.

Claims 9-15 are rejected under 35 U.S.C. 112, second paragraph, as being

indefinite for failing to particularly point out and distinctly claim the subject matter which

applicant regards as the invention.

Regarding Claims 9 and 13, the phrase "execute a program in said reproduction

program data" is unclear, and one of ordinary skill in the art would not be reasonably

apprised of the scope of the invention. The examiner suggests using the phrase

"execute said reproduction program"; the claim has been so construed.

Regarding Claim 11, the phrase "executing a program in a reproduction program

data for reproducing" is unclear, and one of ordinary skill in the art would not be

reasonably apprised of the scope of the invention. The examiner suggests using the

phrase "executing a program for reproducing"; the claim has been so construed.

Regarding Claim 14, the phrase "means for controlling to activate said execution

program" is unclear, and one of ordinary skill in the art would not be reasonably

apprised of the scope of the invention. The examiner suggests using the phrase

"means for activating said execution program"; the claim has been so construed.

Regarding Claim 15, the term "same" is unclear, and it is unknown precisely what

the applicant wants to display. The examiner suggests removing the term; the claim

has been so construed.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 9-11 and 13 are rejected under 35 U.S.C. 102(b) as being anticipated by Boyle (US 2001/0041021).

Regarding Claim 9, Boyle teaches a memory device of a portable type comprising:

(a) a terminal capable of being connected to an interface mounted on a host machine and capable of data input/output from/to said host machine (I/O device 122, connected to host machine 124 via connection 130), and

(b) a storage element for storing at least one of image data and audio data (captured image data 432), reproduction program data for said host machine to reproduce at least one of said image data and audio data (see conversion program description in paragraph 0032), and execution program data for said host machine to execute a program in said reproduction program data and a write program to write at least one of said image data and audio data from said host machine to said storage element in response to a detection signal that said host machine detects a connection of said terminal to said interface (the 'sync manager' runs after the device is connected, also see the description of uploading data from a personal computer to the 'handheld electronic device,' paragraph 0036).

Regarding Clam 10, Boyle teaches a portable memory device as described in

claim 9, wherein if said host machine stores beforehand at least said reproduction

program data and execution program data (imaging conduit 310 of the sync manager,

installed on the host, paragraph 0010), and when said terminal is connected to said

interface in the state that said storage element stores at least one of said image data

and audio data, said host machine activates said execution program in response to said

detection signal to read and reproduce at least one of said image data and audio data

stored in said memory element (the 'sync manager' runs after the device is connected,

also see the description of uploading data from a personal computer to the 'handheld

electronic device,' paragraph 0036).

Regarding Claim 11, Boyle teaches a recording medium (handheld electronic

device 120) recorded therewith programs, said programs comprising:

a program for making a host machine having an interface capable of data

input/output (host 110) execute said program, said program having

(a) a step of detecting a detection signal indicating that a terminal of a portable

memory device is connected to said interface (see how the 'sync manager' runs

after the device is connected, as well as an additional description in paragraph

0010 how the device runs 'without any need for user interaction), and

(b) a step of executing a program in a reproduction program data for reproducing

at least one of image data and audio data stored in said memory device, in

response to said detection signal (see description of how the imaging conduit

reproduces the image data in paragraph 0032); and

a write program to write at least one of said image data and audio data from said

host machine to said storage element (see description of uploading data from a

personal computer to the 'handheld electronic device,' paragraph 0036).

Regarding Claim 13, Boyle teaches a data processing system comprising:

(a) a host machine having an interface capable of data input/output (computing

device 110), and

(b) a portable memory device having a terminal capable of being connected to

said interface (paragraph 0020), and a storage element for storing at least one of

image data and audio data (paragraph 0019), reproduction program data for said

host apparatus to reproduce at least one of said image data and audio data (see

description of how the imaging conduit reproduces the image data in paragraph

0032), execution program data for said host machine to execute a program in

said reproduction program data in response to a detection signal that said host

machine detects a connection of said terminal to said interface (see how the

'sync manager' runs after the device is connected, as well as an additional

description in paragraph 0010 how the device runs 'without any need for user

interaction), and a write program to write at least one of said image data and

audio data from said host machine to said storage element (see description of

uploading data from a personal computer to the 'handheld electronic device,'

paragraph 0036).

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Boyle in view of AppleCare Document: 122014.

Regarding Claim 12, Boyle teaches all limitations of claim 11 as described above. While Boyle mentions that images and 'other such data' (paragraph 0008) may be transferred across to the portable media device, he does not give an example of what this data may be. Apple's iPod, however, enables users to download software from Apple that is transferred from a host machine to the iPod portable memory device automatically once it is connected to the host machine (see first paragraph of AppleCare Document: 122014). It would have been obvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains to download a similar program containing image reproduction data (such as that described in paragraph 0032 in Boyle) onto the host computer and to transfer this data to the handheld device just as the iPod Updater installs software on an iPod. The motivation for this is that it keeps software programs flexible, and any minor bug in a program on a handheld device would be able to fixed by uploading to the handheld device a new version of software from the host (see AppleCare Document: 122014 for a list of bug fixes in the iPod software, for example).

Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Boyle in

view of Kahn (US 2004/0004737).

Regarding Claim 14, Boyle teaches all limitations of Claim 13 as addressed

above. Boyle clearly has a network (218 in Boyle) in his system, but does not explain

what data could be transferred over the network. Kahn teaches a network over which

images are shared, including an external apparatus (image server 331-333 in Kahn). It

would have been obvious at the time the invention was made to a person having

ordinary skill in the art to which the subject matter pertains that Kahn's network could be

the network in Boyle. In this combination, when a device (such as handheld device

110) is connected to a host machine (such as 120 in Boyle) a program (such as the

program specified in Kahn that begins at 522 in Figure 5, also see paragraph 0082) is

run that uploads images to the external apparatus. The motivation for this comes from

Kahn, who states that his network provides the benefits of automatic organization and

easy sharing among friends (paragraph 0089 in Kahn).

Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Boyle in

view of Sesek (US 2003/0076365).

Regarding Claim 15, Boyle teaches all limitations of Claim 9 as addressed

above. Boyle teaches a memory device of a portable type that can store images as well

as programs for exchanging these images, but does not teach displaying these images

as icons or as a reduced image of a file. However, Sesek teaches a technique that

displays reduced images, or "thumbnails" of each image that can be displayed by a host

machine (see paragraphs 0008-0011 in Sesek). It would have been obvious at the time

the invention was made to a person having ordinary skill in the art to which the subject

matter pertains to integrate this display system into the write program that writes

selected files to a portable memory device (such as that described in paragraph 0036 of

Boyle). Motivation for this comes from Sesek, who states that thumbnails 'are useful for

indicating the contents of a page or image' (paragraph 0007 in Sesek) and also that

they allow the user 'to easily select pages or images for viewing' (paragraph 0006 in

Sesek). Thus, by integrating Sesek's technique into the write program, we obtain

additional benefits.

The prior art made of record and not relied upon is considered pertinent to

applicant's disclosure. Hsu et al. teach a way of writing software from a host computer

to a peripheral device. Fukuoka teaches a way of uploading images and other media to

a peripheral device. Beaulieu et al. teach a device for storing images that can download

additional images from a host computer as well as upload images to said host

computer. Tsai et al. teach a peripheral device containing an executable program that

is executed by a host computer once the peripheral device is attached. Kottomtharayil

et al. teach a way of sharing media files from a host computer to external devices. The

iPod Original User's Guide Manual teaches an automatic transfer of audio data from a

host computer to a peripheral device.

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Mark A. Giardino whose telephone number is (571) 270-

3565. The examiner can normally be reached on Monday-Thursday from 7:30 to 5:00.

The examiner can also be reached on alternate Fridays from 7:30 to 4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, David Robertson, can be reached on Monday-Thursday from 7:30 to 5:00.
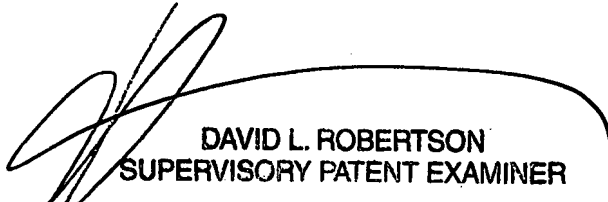
The fax phone number for the organization where this application or proceeding is

assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the

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published applications may be obtained from either Private PAIR or Public PAIR.

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you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free).

M. A. Giardino

8/21/2007

DAVID L. ROBERTSON
SUPERVISORY PATENT EXAMINER